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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 46321
	:	
Joseph A. RUSSO, et al.	:	Confirmation Number: 5725
	:	
Application No.: 10/737,131	:	Group Art Unit: 2154
	:	
Filed: December 15, 2003	:	Examiner: Wen-Tai Lin
	:	
For: COMMUNITY ENROLLMENT MODELING	:	

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed July 30, 2008, wherein Appellant appeals from the Examiner's rejection of claims 1-10.

I. REAL PARTY IN INTEREST

This application is assigned to International Business Machines Corporation by assignment recorded on December 15, 2003, at Reel 014803, Frame 0439.

II. RELATED APPEALS AND INTERFERENCES

Appellant is unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 11-30 were cancelled. Claims 1-10 are pending in this Application and have been twice rejected. It is from the multiple rejections of claims 1-10 that this Appeal is taken.

IV. STATUS OF AMENDMENTS

The claims have not been amended subsequent to the imposition of the Final Office Action dated April 30, 2008 (hereinafter the Final Office Action).

V. SUMMARY OF CLAIMED SUBJECT MATTER

Referring to Figures 1 and 3-6 and also to independent claim 1, a method for managing member enrollment in a collaborative computing community is disclosed (lines 1-3 of paragraph [0017]). The method for managing member enrollment in a collaborative computing community can include identifying one or more end user persons for enrollment in the collaborative computing community and implementing an enrollment model to determine whether to enroll the one or more identified end user persons as members in the community (lines 4-8 of paragraph [0006]). The method further can include updating community membership to enroll the one or more end user persons based on the implemented enrollment model (lines 8-10 of paragraph [0006]). The implementing of enrollment models can include designating one or more community members as administrators with the authority to grant enrollment to the one or more end user persons (lines 2-5 of paragraph [0022]), identifying one or more criteria for defining a role in the collaborative computing community (lines 5-6 of paragraph [0024]), providing one or more of the end user persons with the ability to grant enrollment to themselves (lines 1-4 of

paragraph [0029]), and designating one or more community members as a sponsor member having privileges, the sponsor member granted a further privilege of sponsoring one or more of the end user persons for community membership as a sponsored member, wherein the sponsored member is granted enrollment in the community with privileges equal or less than the privileges of the sponsor member (lines 1-12 of paragraph [0030]).

VI. GROUNDS OF REJECTIONS TO BE REVIEWED ON APPEAL

1. Claims 1-9 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,480,885 to Oliver (Olivier); and
2. Claim 10 have been rejected under 35 U.S.C. § 103(a) for obviousness based upon Olivier.

VII. THE ARGUMENT

THE REJECTION OF CLAIMS 1-9 UNDER 35 U.S.C. § 102 FOR ANTICIPATION BASED UPON OLIVIER

For the convenience of the Honorable Board in addressing the rejections, claims 2, 4-7 and 8 stand or fall together with independent claim 1; claim 3 stands or falls with claim 2; claims 9-10 stand or fall together with claim 8.

As is evident from Appellant's previously-presented comments during prosecution of the present Application and from Appellant's comments below, there are questions as to how the limitations in the claims correspond to features in the applied prior art. In this regard, reference

is made to M.P.E.P. § 1207.02, entitled “Contents of Examiner’s Answer.” Specifically, the following is stated:

(A) CONTENT REQUIREMENTS FOR EXAMINER’S ANSWER. The examiner’s answer is required to include, under appropriate headings, in the order indicated, the following items:

...

(9)(c) For each rejection under 35 U.S.C. 102 or 103 where there are questions as to how limitations in the claims correspond to features in the prior art even after the examiner complies with the requirements of paragraphs (c) and (d) of this section, the examiner must compare at least one of the rejected claims feature by feature with the prior art relied on in the rejection. The comparison must align the language of the claim side-by-side with a reference to the specific page, line number, drawing reference number, and quotation from the prior art, as appropriate. (emphasis added).

Therefore, if the Examiner is to maintain the present rejections and intends to file an Examiner’s Answer, the Examiner is required to include the aforementioned section in the Examiner’s Answer.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.¹ Moreover, the anticipating prior art reference must describe the recited invention with sufficient clarity and detail to establish that the claimed limitations existed in the prior art and that such existence would be recognized by one having ordinary skill in the art.²

“Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims. ... The second step in the analyses requires a comparison of the properly construed claim to the prior art.”³ During patent examination, the pending claims must be “given their broadest reasonable interpretation

¹ *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

² See *In re Spada*, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); *Diversitech Corp. v. Century Steps Inc.*, 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

³ *Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

consistent with the specification,"⁴ and the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.⁵ Therefore, the Examiner must (i) identify the individual elements of the claims and properly construe these individual elements,⁶ and (ii) identify corresponding elements disclosed in the allegedly anticipating reference and compare these allegedly corresponding elements to the individual elements of the claims.⁷ This burden has not been met. In this regard, the Examiner's rejection under 35 U.S.C. § 102 also fails to comply with 37 C.F.R. § 1.104(c).⁸

Prior to addressing the specifics of the Examiner's rejection, Appellants wish to address certain themes that have been consistently present throughout the extensive prosecution of the present application. The Examiner's analysis appears to be conclusion-based in that the Examiner's desired conclusion (i.e., the claims are identically disclosed by the prior art) is driving the Examiner's analysis of the prior art instead of having the Examiner's analysis of the prior art driving the Examiner's conclusion.

As identified by Appellants throughout the prosecution of the present Application, the Examiner's analysis fails to specifically identify many of the claimed elements relied upon by the Examiner in rejecting the claims. Moreover, although the Examiner has consistently "interpreted

⁴ In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

⁵ In re Corrigan, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999)

⁶ See also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, . . . will normally control the remainder of the decisional process"); see Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

⁷ Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

⁸ 37 C.F.R. § 1.104(c) provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

broadly"⁹ the language of the claim, the Examiner fails to (i) provide explicit claim constructions for the language at issue; (ii) explain why the Examiner's claim construction is both broad and *reasonable*; (iii) explain why the Examiner's claim construction is consistent with Appellants' specification and consistent with the meaning one having ordinary skill in the art would attribute to the language; and (iv) provide factual support for any of the Examiner's analysis. Instead, the Examiner's analysis consists of conclusory statements that the applied prior art teaches the limitation of the claims without substantive explanation.

Claim 1

In Applicants' response to the First Office Action, the Applicants stated that Applicants' claims all refer explicitly to a "collaborative computing community". *Nowhere in Olivier is a collaborative computing community disclosed.* Exemplary claim 1 recites as follows:

1. A method for managing member enrollment in a collaborative computing community, the method comprising:
 - identifying one or more end user persons for enrollment in the collaborative computing community;
 - implementing an enrollment model to determine whether to enroll the one or more identified end user persons as members in the community; and
 - updating community membership to enroll the one or more end user persons based on the implemented enrollment model.

In paragraph 5 of the Final Office Action, the Examiner expressly stated that the "identifying one or more end user persons for enrollment in the collaborative computing community" is disclosed in the Abstract of Olivier. A careful examination of the Abstract of Olivier fails to find any mention of a "identifying one or more end user persons for enrollment in the collaborative computing community". Instead, the Abstract of Olivier is limited to

⁹ See, e.g., paragraphs 5-10 of the Final Office Action.

describing a method for “enabling users to exchange group electronic mail by establishing individual profiles and criteria (see lines 1-3 of the Abstract of Olivier).

The Abstract of Olivier is a far cry from the “collaborative computing community” of the Applicants. In particular, the Applicants have defined the “collaborative computing community” as being “defined by (1) a particular context, i.e., the objective of the environment, (2) membership, i.e., the participants in the environment, (3) a set of roles for the members, and (4) resources and tools which can be accessed by the membership in furtherance of the objective of the environment” (See paragraph [0003] of Applicants’ specification).

In paragraph 18, the Examiner stated that:

...Olivier teaches that a member may volunteer to be a moderator functioning as a human filter for inappropriate messages, scanning for “spam”, and other messages that shouldn’t be sent to subscribers. At col. 17 lines 7-20, a special role called “approval user” is described in forming a professional jazz team...For example, spam filtering and language translation tools are described at col. 17, lines 21-39. Servers functioning at different stages of community activities are depicted in Fig. 7 and its related passages. All of which can be accessed by the membership in furtherance of the objective of the environment.

For ease of reference, the Examiner’s cited passages are reproduced below:

An example is a professional sub-group of a jazz mailing list. Subscribers checking the “Professional” experience checkbox would need to be approved before admittance. In this case, the subscriber is told that his subscription will need to be approved, and his subscription record is stored in a pending subscriptions table. The approval user is emailed with a request for approval. If the approval does not take place within 14 days, the subscriber is automatically rejected by the system. (emphasis added)

And;

Another additional feature is to install a process near the beginning of the email distribution process for eliminating unwanted commercial email (“spam”). Such systems are commercially available and are configured independently of this invention. The email server process would allow the service provider to configure it to incorporate a spam elimination process at the appropriate step in the process. (emphasis added)

And:

Another alternative embodiment to FIG. 5B is depicted in FIG. 7. In this embodiment, the matching is done through multiple computers operating as a distributed system. All communication between computers is through a standard means such as CORBA. A Match Dispatch Server computer distributes the matching process across a cluster of Match Servers. Each match server handles part of the total number of subscriptions in the system. Each match server keeps its own cached copy of the database data for high-speed access during the matching process. To conduct a match, a client sends a match request to the Match Dispatch

Server ("dispatcher"). The dispatcher has a lookup table describing which Match Servers are needed to compute a particular match. The dispatcher returns a list of Match Servers to use in completing a dynamic match. The client then requests those match servers to perform partial matches, and the results are combined for the final answer. The lookup table is centralized on the dispatcher system. Data changes (e.g., from a user tuning his community settings on the web site) will first be stored in an SQL database, and then updates distributed to appropriate server(s). Although FIG. 7 only shows a single dispatcher, multiple redundant dispatchers may be used.

How these passages identically disclose the claimed invention is entirely unclear. For example, the cited passage of Olivier is specifically directed to a "mailing list" from which a subscriber can receive electric mail, which falls short of a "collaborative computing environment" as recited in claim 1. Moreover, the cited passage is silent as to what "enrollment model" is to be implemented. In addition, the Examiner's reliance on col 17, lines 21-29 to teach "various resources and tools" made available for use in the electronic mail system of Olivier. In fact, Olivier teaches in the cited passage that the "email server process would allow the service provider to configure it to incorporate a spam elimination process." There is no indication that an individual user or subscriber would deploy or implement the "spam filter" selectively.

The Examiner's reliance on the "language translation tool" is also misplaced. The cited passage of Olivier is silence as to any collaborative endeavor of different users or subscribers with respect to the language translation tool. Specifically, the "user specifies the language of choice as part of the subscription process" (col. 17, lines 30-31 of Olivier). In other words, when the user initially subscribes to the Olivier email distribution process, that user selects a language that the user prefers to receive email messages. Accordingly, the cited passages by the Examiner fail to support the elements and/or limitations that the Examiner has relied on them to teach or disclose. Therefore, the Examiner has failed to establish that Olivier identically discloses the claimed invention, as recited in claim 1, within the meaning of 35 U.S.C. § 102. Appellant respectfully requests that the Honorable Board reverse this rejection.

Claim 2

At paragraph 6 of the Office Action, the Examiner erroneously asserts that Fig. 8; col.10, lines 43-59 of Olivier discloses “wherein implementing an enrollment model includes designating one or more community members as administrators with the authority to grant enrollment to the one or more end user persons,” as recited in claim 2. For the convenience of the Honorable Board a verbatim reproduction of the recited portion of Olivier is provided herein:

To summarize by way of example, suppose a user decides to try out a mailing list that uses this invention. He signs up at the service provider's web site, selecting a mailing list about the topic of financial investments. He specifies (user profile acceptance criteria data) he would like to interact with other men of age 40-50 who live within three miles of him and do not have children. Using an optional feature, he selects the subtopics (message criteria) related to internet stocks, junk bonds, and international mutual funds. The system responds with a preview of 38 matching subscribers and five messages per week. He wants more people to interact with, so he increases his age criteria to include men between 35-55. He also increases his distance criteria to five miles. Now the system matches him with 68 people and 12 messages per week, and he accepts the setup. The system stores that subscription; soon he will begin interacting with his matched subscribers. 1. (emphasized added).

Notably, there is no mention of “wherein implementing an enrollment model includes designating one or more community members as administrators with the authority to grant enrollment to the one or more end user persons”. In contrast, Fig. 8; col.10, lines 43-59 of Olivier teaches that a list of potential users that matched that users inquiry, but the passage is silence to the “authority to grant enrollment to the one or more end user persons”. Accordingly, the Examiner has failed to establish that the applied art teaches all of the claimed features. Specifically, the Examiner’s analysis ignores the active step of “granting enrollment to the one or more end user persons” as claimed.

Accordingly, the Examiner has failed to designate the teaching in Olivier being relied upon to state the rejection. In this regard, the Examiner’s rejection under 35 U.S.C. § 103 fails to comply with 37 C.F.R. § 1.104(C). Thus, as it will be clear to the Honorable Board, Olivier fails as a reference to anticipate the claimed invention.

THE REJECTION OF CLAIM 10 UNDER 35 U.S.C § 103(A) FOR OBVIOUSNESS BASED

UPON OLIVIER

For the convenience of the Honorable Board in addressing this rejection, claim 10 stands or falls together with claim 8.

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). *See also KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007) (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”).

Dependent claim 10 depends from dependent claims 8 and 9, and recites the additional feature of “wherein the sponsored member is enrolled as a community member after the passage of a predetermined amount of time.”

Yet, Olivier fails to teach or suggest a “sponsored member” being “enrolled as a community member after the passage of a predetermined amount of time” as recited in Claim 10.

Moreover, in paragraph 15 of the Final Office Action, the Examiner acknowledges:

Olivier **does not specifically teach** the sponsored member is enrolled as a community member after the passage of a predetermined amount of time. However, Olivier teaches that approving all new members can be done via email or web-based approval mechanism [e.g., col. 15, lines 61-64] (which typically incurs some processing time before a decision can be made) and that when approval is not received within 14 days, the subscriber is automatically

rejected by the system [col. 17, lines 12-20] (which takes out some uncertainty that a subscriber might experience). Further, it is **typical** in an approval mechanism of foretelling a subscriber to wait for certain fixed amount of time to receive a notification. (emphasis added)

The Examiner argument is flawed in that the cited passage does not teach that the “sponsored member is enrolled as a community member after the passage of a predetermined amount of time.” In direct contrast, Olivier teaches that a subscriber is “automatically rejected (i.e., NOT enrolled) after 14 days. In this regard, the Examiner’s rejection under 35 U.S.C. § 103 fails to comply with 37 C.F.R. § 1.104(C). Thus, as it will be clear to the Honorable Board, Olivier fails as a reference to sufficiently establish a prima facie case of obviousness.

Conclusion

Based upon the foregoing, Appellants respectfully submit that the Examiner's rejections under 35 U.S.C. §§ 102(b) and 103(a) based upon Olivier are not viable. Appellants, therefore, respectfully solicit the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. §§ 102(b) and 103(a).

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 12-2158, and please credit any excess fees to such deposit account.

Date: September 30, 2008

Respectfully submitted,

/Steven M. Greenberg/
Steven M. Greenberg,
Registration No. 44,725
Adam C. Underwood
Registration No. 45,169
Customer Number 46321
Tel: (561) 922-3845

VIII. CLAIMS APPENDIX

1. A method for managing member enrollment in a collaborative computing community, the method comprising:

identifying one or more end user persons for enrollment in the collaborative computing community;

implementing an enrollment model to determine whether to enroll the one or more identified end user persons as members in the community; and

updating community membership to enroll the one or more end user persons based on the implemented enrollment model.

2. The method of claim 1, wherein implementing an enrollment model includes designating one or more community members as administrators with the authority to grant enrollment to the one or more end user persons.

3. The method of claim 2, further including providing the one or more community members with the ability to remove a community member from the community.

4. The method of claim 1, wherein implementing an enrollment model to determine whether to enroll the one or more identified end user persons as members in the community includes:

identifying one or more criteria for defining a role in the collaborative computing community;

obtaining role profiles for each of the end user persons; and

determining if one or more role profiles match the one or more criteria.

5. The method of claim 4, wherein the one or more criteria for defining a role in the collaborative computing community includes payment of a predetermined fee.
6. The method of claim 1, wherein implementing an enrollment model includes providing one or more of the end user persons with the ability to grant enrollment to themselves.
7. The method of claim 6 further including providing the one or more end user persons with the ability to remove themselves from the community.
8. The method of claim 2, wherein implementing an enrollment model includes designating one or more community members as a sponsor member having privileges, the sponsor member granted a further privilege of sponsoring one or more of the end user persons for community membership as a sponsored member, wherein the sponsored member is granted enrollment in the community with privileges equal or less than the privileges of the sponsor member.
9. The method of claim 8, wherein the sponsored member is enrolled as a community member if voted into the community.
10. The method of claim 8, wherein the sponsored member is enrolled as a community member after the passage of a predetermined amount of time.

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellant in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Since Appellant is unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.